



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,209	02/29/2000	Terry Allen-Rouman	00617425	1082

7590

03/18/2002

Darin J. Gibby  
Townsend and Townsend and Crew LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, CA 94111

EXAMINER

BASHORE, ALAIN L

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

12

**Office Action Summary**

Application No.

09/516,209

Applicant(s)

ROUMAN ET AL.

Examiner

Alain L. Bashore

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 February 2000 and 08 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-18 and 23-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-18 and 23-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

The summary is not considered brief. Applicant is reminded regarding content of the summary as follows:

Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

Appropriate correction is required.

### *Information Disclosure Statement*

2. The information disclosure statement filed 4-14-00 regarding the non-patent documents section fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 for the reasons given below:

the specification would be objected to regarding hyperlinks and/or form of browser-executable code. Applicant is required to delete the embedded hyperlinks and/or other form of browser-executable code. See MPEP § 608.01;

citations are not listed on the PTO-1449 (attaching pages that are not on the PTO-1449 is unacceptable);

citations are not listed on the PTO-1449 in conformance for citation description purposes (i.e. including author, title, data, pertinent pages, etc..).

The attachment to the IDS filed 4-14-00 has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23, 28, 34 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 28, 34, and 38 are independent claims, as now presented, and do not have a complete claim recitation structure as required by U.S. practice. An independent claim may not refer to another claim. If these claims are considered dependant claims they are objected to as claiming separate inventions because the preamble does not refer to the same invention (a computer-readable medium having computer-executable instructions is separate from a method).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2164

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14-18, 23-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Rowney et al.

There is disclosed a method for facilitating an electronic purchase as the transferring funds from a payor to a payee (figure 4). Purchase information from a vendor and purchaser information from a purchaser are both received as payment information (122) from a funds transfer system. When the payment information is validated, the vendor is notified (130) and funds are transferred. The purchase information includes a purchase price, and the purchaser information includes an identification of a purchaser account. When the purchaser information is not validated (figure 7), a message is sent to the purchaser (46) and the purchaser is added to a database. The confirming of the digital IOU comprises comparing digital signatures.

There is disclosed establishing a connection from the funds transfer system to the user during check-out of the user with a vendor system. The funds transfer system is separate from the vendor system. The transfer of funds is from a user account to a vendor account where at least one of the accounts is a bank account. The user account may be a credit card account.

A funds transfer system is disclosed for paying in a transaction with a purchaser, wherein the vendor uses a vendor system and the purchaser uses a purchaser system during the transaction. A first and second connection is made between a vendor and purchaser system. Means for validating the transaction is disclosed. The means for

validating include: a machine readable medium, means for receiving purchase information, means for receiving payment information, means for comparing, and means for paying. The means for paying may be an ACH. The means for means for receiving purchase information and means for receiving payment information may be a FTP over a network.

Kolling et al does not explicitly disclose:

a digital IOU;

confirming the digital IOU by comparing a digital signature;

as part of the check-out of the user with a vendor system.

Rowney et al discloses check-out of the user with a vendor system and comparing digital signatures.

It would have obvious to one with ordinary skill in the art to modify Kolling et al to include a digital IOU because both Kolling et al and Rowney et al teach notifications that payments will be made and Kolling et al teaches service bureaus that may operate by IOUs with their customers (col 6, lines 50-67).

It would have obvious to one with ordinary skill in the art to modify Kolling et al to include confirming the digital IOU by comparing a digital signature since Rowney et teaches digital signatures for security purposes.

It would have obvious to one with ordinary skill in the art to modify Kolling et al to include as part of the check-out of the user with a vendor system since Rowney et al teaches importance of assessing transaction risk (col 12, lines 5-6).


**Conclusion**


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morrill, Jr., Bernstein, Hilt et al, and Kravitz are made of record.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:30 am to 5:00 pm (Alternate Fridays Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Alain L. Bashore  
March 7, 2002

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100